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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/814,066	06/21/2001	Franz Knauseder	P26741	2541
7055 7590 01/02/2008 GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			EXAMINER SAFARI, MICHAEL	
			ART UNIT 3637	PAPER NUMBER
			NOTIFICATION DATE 01/02/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	09/814,066	KNAUSEDER, FRANZ	
	Examiner	Art Unit	
	M. Safavi	3637	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 4-20 and 26-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 21-25 and 31-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on March 22, 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10/16/07</u> . | 6) <input type="checkbox"/> Other: _____ |

A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on October 16, 2007 has been entered.

Information Disclosure Statement

The information disclosure statement filed October 16, 2007 fails to fully comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the IDS of 10/16/07 does not provide an explanation of relevance for foreign reference listed as SU 1434144. The IDS of 10/16/07 does not provide an explanation of relevance for foreign reference listed as Germany 3834026. The IDS of 10/16/07 does not provide an explanation of relevance for foreign reference listed as Switzerland 497 524. The IDS of 10/16/07 does not provide an explanation of relevance for foreign reference listed as Germany 195 47 864. The IDS of 10/16/07 does not list a proper publication date for foreign reference listed as United Kingdom 213,337. The IDS of 10/16/07 does not list a publication date for nor provide a full copy of foreign reference listed as EPO 1 287 219. The IDS of 10/16/07 does not provide an explanation of relevance for foreign reference listed as EPO 1 229 182. The IDS of 10/16/07 does not provide an explanation of relevance for foreign reference listed as France 1,147,651. It has been placed in the

application file, but the information referred to therein, with respect to each of SU 1434144, Germany 3834026, Switzerland 497 524, Germany 195 47 864, United Kingdom 213,337, EPO 1 287 219, EPO 1 229 182, and France 1,147,651 has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

Further, the IDS of 10/16/07 lists U.S. Patents 5,639,027 to Fritz et al. and 6,004,417 to Roesch et al. when each of U.S. Patents 5,639,027 to Fritz et al. and 6,004,417 to Roesch et al. have already been cited by the examiner in the Notice of References Cited of March 22, 2002.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 12, 13, 14, 15, 21, and 22. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the

sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3 and 25 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3, it is not clear as to what is being defined by "a covering or strand is applied to the panels and moistens them shortly before they are joined together and comprises an activator which induces adhesion." Is the recited "covering or strand" an alternative to either of the "coating or surface impregnation"? Are the "covering" and "strand" one and the same? It is not clear as with what the tongues are provided. Does the recitation "a covering or strand is applied to the panels and moistens them shortly before they are joined together and comprises an activator which induces adhesion" serve to define an intended procedural step? Otherwise, it is not clear as to what "and moistens them shortly before they are joined together" defines. Further, it is not clear as

to what is being defined by "and comprises an activator which induces adhesion." Does the tongue of claim 3 have both "an activator which induces adhesion" as well as "a covering or strand...applied to the panels...[which] moistens them shortly before they are joined together"? The metes and bonds of the language of claim 3 can therefore, not be ascertained.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-3, 21-25, and 31-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Austrian reference 405,560 to Kaindl, (Kaindl '560), in view of German reference 29703962 to Witex Co., (Witex Co. '962).

Kaindl '560 discloses the configuration of attaching flat structural cladding or substrate components as recited in claims 1-20 of the instant application. Kaindl '560 does not appear to disclose any specific use of adhesive with the attaching configuration. However, Witex Co. '962 teaches utilization of a pre-applied contact adhesive between tongue and groove joints so as to establish a secure engagement between cladding panels of a substrate. Witex Co. '962 discloses a "contact glue" as well as a glue activated by heat with both disclosed as pre-applied at the factory, (see

translation of Witex Co. '962 as at page 4, line 19 to page 5, line 4; page 5, line 20 to page 6, line 6; page 7, lines 6-11; and page 8, lines 2-5 and 10-13).

Therefore, to have provided the floor tile assembly of Kaindl '560 with adhesive, including a pre-applied adhesive, between and within the tongue and groove joints connecting the panels 1, 2, thus securely fastening adjacent floor tiles one to another while realizing any and all advantages of adhesives within a self-locking joint, would have constituted an obvious expedient to one of ordinary skill in the art at the time the invention was made as taught by Witex Co. '962. The recitations to "a pre-applied adhesive layer" as well as "applied off site" have not been afforded patentable weight as being directed to process in a claim to article of manufacture. However, Witex Co. '962 obviously teaches application of the adhesive "prior to connection" at "another site", (i.e., teaches "a pre-applied adhesive layer" as well as "applied off site").

As concerns **claim 3**, the resulting panels would be "provided with a...coating [of adhesive] in the groove areas. Lines 5-7 of claim 3 appear directed to a process particularly, with apparent recitation of an element not utilized until the panels are connected together. Otherwise, any adhesive coating would moisten the tongue and/or groove area upon application thereto.

As concerns **claim 25**, the resulting panels would have at least one of the lateral groove areas of the grooves provided with the adhesive and at least one of the sides of the tongue provided with the adhesive.

As concerns **claims 32, 33, and 35**, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided adhesive in

any quantity including an amount that would not allow for excess adhesive to spill out onto the facing, (or decorative), surface, thus serving to minimize if not completely eliminate undesirable effects of seepage of any excess adhesive as is taught by Witex Co. '962 on page 4, lines 1-6 and page 5, lines 7-9.

Claims 1-3, 21-25, and 31-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Austrian reference 405,560 to Kaindl, (Kaindl '560), in view of German reference 29703962 to Witex Co., (Witex Co. '962), as applied to claims 1-3, 21-25, and 31-35 above, and further in view of Roesch et al.

Though the limitation presented within each of claims 1, 31, and 34 to "pre-applied adhesive layer" is deemed met by the above rejection of claims, Roesch et al., for example, teach utilization and advantages of various "two component" adhesives including microencapsulatable solvent adhesives that contain polymer resin and appropriate solvents as well as polyvinyl acetate base, methyl acrylate base, epoxide base etc. with such adhesives falling into a category of "latent adhesive material that becomes active after appropriate activation" along with "an activator which induces adhesion". Roesch et al. teaches application to either one or both members being connected, col. 10, line 9. Roesch et al. further teaches application to either one or both members "prior to connection" at "another site", (i.e., teaches "a pre-applied adhesive layer" as well as "applied off site"), col. 10, lines 36-40 and col. 5, lines 54-58.

Therefore, to have provided the modified floor tile assembly of Kaindl '560 with a pre-applied two component adhesive, (including adhesive with activating substance,

microencapsulated adhesive, etc.), between and within the tongue and groove joints connecting the panels 1, 2, thus securely fastening adjacent floor tiles one to another while realizing any and all advantages of such well known adhesives and particularly “two component adhesives”, would have constituted an obvious expedient to one of ordinary skill in the art at the time the invention was made as taught by Roesch et al. The recitations to “a pre-applied adhesive layer” as well as “applied off site” have not been afforded patentable weight as being directed to process in a claim to article of manufacture. However, Roesch et al. obviously teaches application of the adhesive “prior to connection” at “another site”, (i.e., teaches “a pre-applied adhesive layer” as well as “applied off site”).

As concerns **claim 3**, the resulting panels would be “provided with a...coating [of adhesive] in the groove areas. Lines 5-7 of claim 3 appear directed to a process particularly, with apparent recitation of an element not utilized until the panels are connected together. Otherwise, any adhesive coating would moisten the tongue and/or groove area upon application thereto. However, the adhesive taught by Roesch et al. would read upon “latent adhesive material that becomes active after appropriate activation” as well as “coating...is applied to the panels and moistens them shortly before they are joined together and comprises an activator which induces adhesion”.

As concerns **claim 25**, the resulting panels would have at least one of the lateral groove areas of the grooves provided with the adhesive and at least one of the sides of the tongue provided with the adhesive.

As concerns **claims 32, 33, and 35**, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided adhesive in any quantity including an amount that would not allow for excess adhesive to spill out onto the facing, (or decorative), surface, thus serving to minimize if not completely eliminate undesirable effects of seepage of any excess adhesive as is taught by Witex Co. '962 on page 4, lines 1-6 and page 5, lines 7-9.

As concerns **claim 36**, the resulting panels would have at least one component of a two-component glue along a first, (or tongue), edge and at least another component of the two-component glue along a second, (or groove), edge.

Claims 32, 33, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Austrian reference 405,560 to Kaindl, (Kaindl '560), in view of German reference 29703962 to Witex Co., (Witex Co. '962), as applied to claims 1-3, 21-25, and 31-35 above, and further in view of any of Robins et al. '902, Sjostedt et al. '715, Parasin '816, and Ryther '892.

Though the limitation presented within each of claims 32, 33, and 35 appear as a presumed or desired effect which one of ordinary skill in the art would have obviously desired, each of Robins et al., Sjostedt et al., Parasin, and Ryther recognize the undesirability of excess adhesive seepage and therefore teach to abate as much as possible any undesirable effects of any possible excess adhesive seepage, col. 4, lines 11-13 of Robins et al.; col. 9, line 65 to col. 10, line 10 of Sjostedt et al.; col. 3, lines 18-20 and claim 4 of Parasin; and col. 1, lines 63-67, col. 2, lines 32-36, col. 3, lines 18-20,

and col. 4, lines 33-35 of Ryther. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the modified Kaindl '560 assembly with adhesive in any quantity including an amount that would not allow for excess adhesive to spill out onto the facing, (or decorative), surface, thus serving to minimize if not completely eliminate undesirable effects of seepage of any excess adhesive as taught by any of Sjostedt et al., Parasin, and Ryther.

Claims 32, 33, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Austrian reference 405,560 to Kaindl, (Kaindl '560), in view of German reference 29703962 to Witex Co., (Witex Co. '962), when considering Roesch et al. as applied to claims 1-3, 21-25, and 31-36 above, and further in view of any of Robins et al. '902, Sjostedt et al. '715, Parasin '816, and Ryther '892.

Though the limitation presented within each of claims 32, 33, and 35 appear as a presumed or desired effect which one of ordinary skill in the art would have obviously desired, each of Robins et al., Sjostedt et al., Parasin, and Ryther recognize the undesirability of excess adhesive seepage and therefore teach to abate as much as possible any undesirable effects of any possible excess adhesive seepage, col. 4, lines 11-13 of Robins et al.; col. 9, line 65 to col. 10, line 10 of Sjostedt et al.; col. 3, lines 18-20 and claim 4 of Parasin; and col. 1, lines 63-67, col. 2, lines 32-36, col. 3, lines 18-20, and col. 4, lines 33-35 of Ryther. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the modified Kaindl '560 assembly with adhesive in any quantity including an amount that would not

allow for excess adhesive to spill out onto the facing, (or decorative), surface, thus serving to minimize if not completely eliminate undesirable effects of seepage of any excess adhesive as taught by any of Sjostedt et al., Parasin, and Ryther.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Safavi whose telephone number is (571) 272-7046. The examiner can normally be reached on Mon.-Fri., 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on (571) 272-6867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

M. Safavi
December 16, 2007



MICHAEL SAFAVI
PRIMARY EXAMINER
ART UNIT 3637